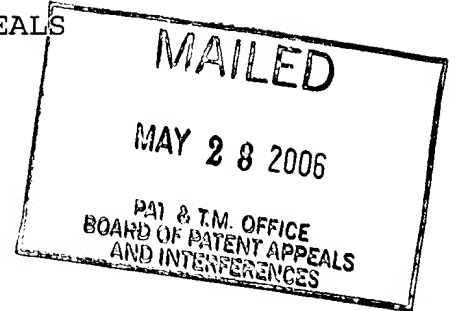


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARCO SCIBORA

Application No. 09/266,183



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on March 27, 2006. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

An Information Disclosure Statement (IDS) was filed on March 30, 2005. There is no indication in the record that this IDS has been considered. According to MPEP § 609 which states:

" The Examiner must also fill in his or her name and the date the information was considered in blocks at the bottom of the PTO-1449 or PTO/SB/08B form."

Upon review of the Examiner's Answer mailed October 6, 2005, it appears that the Examiner's Answer cites "Kaplan US Patent 5,734,719" as prior art of record. However, under the heading "Claim Rejections - 35 USC § 103" on page 5, paragraph 2, the examiner references Kaplan US 5,237,157. A clarification of which reference is the prior art relied upon in the rejection is required.

On February 21, 2006, the examiner mailed a communication acknowledging receipt of Appellant's Reply Brief, dated December 1, 2005. A review of the Response to Reply Brief reveals that the examiner did not provide proper acknowledgment. The comments made by the examiner would constitute being a Supplemental Examiner's Answer.

In accordance with MPEP § 1207.05:

Every supplemental examiner's answer must be approved by a Technology Center (TC) Director or designee. The examiner may furnish a supplemental examiner's answer in response to any one of the following:

1. (A) *A reply brief that raises new issues.* The examiner may NOT include a new ground of rejection in the supplemental examiner's answer responding to a reply brief. See 37 CFR 41.43(a)(2). Appellant may file another reply brief in response to the supplemental examiner's answer within two months from the mailing of the supplemental answer. See MPEP § 1208.

2.(B) *A remand by the Board for further consideration of a rejection under 37 CFR 41.50(a).* See MPEP § 1211.01. In response to a supplemental examiner's answer that is written in response to a remand by the Board for further consideration of a rejection, appellant must either file: (1) a reply under 37 CFR 1.111 to request that prosecution be reopened; or (2) a reply brief to request that the appeal be maintained, within two months from the mailing of the supplemental examiner's answer, to avoid, *sua sponte* dismissal of the appeal as to the claims subject to the rejection for which the Board has remanded the proceeding. Examiner may include a new ground of rejection in the supplemental examiner's answer responding to a remand by the Board for further consideration of a rejection. See MPEP 1207.03.

3(C) *A remand by the Board for other purposes that are not for further consideration of a rejection under 37 CFR 41.50(a).* The examiner may NOT include a new ground of rejection in the supplemental examiner's answer responding to a remand by the Board, unless the remand is for further consideration of a rejection under 37 CFR 41.50(a) (see item B above). Appellant may file a reply brief with two months from the mailing of the supplemental answer.

A review of the Response to Reply Brief reveals that the examiner did not provide proper approval.

Accordingly, it is

ORDERED that the application is returned to the Examiner to:

- 1) consideration of the IDS;
- 2) clarify which Kaplan reference is to be considered as the prior art;

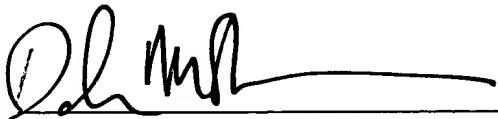
3) vacate the Examiner's Acknowledgment to the Reply Brief mailed February 21, 2006;

4) proper acknowledgment of the Reply Brief is required and/or appropriate consideration of the Reply Brief dated December 1, 2005;

5) acquiring approval for any Supplemental Examiner's Answer in response to the Reply Brief mailed December 1, 2005, if appropriate; and

6) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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